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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/650,289 | 08/28/2003 | Bradley D. Schweigert | KMC-598 | 6682 |
| 39915 | 7590 | 11/02/2005 | EXAMINER | |
| KARSTEN MANUFACTURING CORPORATION LEGAL DEPARTMENT 2201 WEST DESERT COVE PHOENIX, AZ 85029 | | | HUNTER, ALVIN A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3711 | |

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,289

Applicant(s)

SCHWEIGERT ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 2/14/05 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujimaru (JP 2001-037928).

Regarding claim 1, Fujimaru discloses a putter having a club head body ^{having} ~~having~~ a toe region, a heel region, a sole, and a top surface opposite the sole, a hosel coupled to the top surface and configured to accept a shaft, wherein the club head body has a toe thickness defined by a distance between the top surface and the sole in the toe region and a heel thickness defined by a distance between the top surface and the sole in the heel region (See Figure 2). The toe thickness is greater than the heel thickness, as shown in Figure 2, and the heel region is weight-compensated to substantially balance with the toe region as shown in Figure 1 (See Entire Document). Figures 2, 3, 7 and 10

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clearly show the top surface opposite the sole parallel with a reference surface wherein the top surface is parallel with the reference surface.

Regarding claim 7, in the broadest reasonable interpretation, Fujimaru discloses the final product in which the applicant claims. Therefore, it is submitted that the club head body as shown in figures 1 and 2, have a first toe cut-out (cut out extending from the top of the toe side to the recess bottom of the toe side) having a first depth and a heel cut out (concave groove near the hosel) having a second depth wherein the first depth is greater than the second depth.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimaru (JP 2001-037928).

Regarding claims 3 and 4, Applicant recites on page 4, paragraph 0018

“Top surface 130 may be of any suitable shape, width, and length. . . . The present invention, however, is not so limited, and contemplates any suitable club head shape.”

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a concave top surface.

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Applicant has not set forth that having a concave top surface provides any advantage, particular purpose, or solves a stated problem. One having ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally as well with the top surface of Fujimaru because it provides a means to which the hosel may be coupled to the club head body.

Regarding claim 5, though Fujimaru does not explicitly disclose the toe-up factor being 1.20 to 1.40, one having ordinary skill in the art would have recognized that Fujimaru inherently has a toe-up factor being that the drawings show the heel region being less than the toe region and that any factor may be multiplied to the thickness of the heel region such that the value equals that of the toe region. . Furthermore, applicant does not disclose why the values of the toe-up factor are critical in order to attain the invention; therefore, one having ordinary skill would have found it obvious to have the toe-up factor of any value so long as the invention is attained (See *Gardner v. TEC Systems, Inc., et al.* 220 USPQ 777).

Regarding claim 6, Fujimaru discloses the heel region weight compensated such that the center of gravity of the club head body lies in the heel region (See Entire Document). One having ordinary skill in the art would have drawn therefrom that the center of gravity may be at any location so long as the invention is attained and, therefore, would have concluded that the location of the center of gravity is obvious.

Claims 2 and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujimaru (JP 2001-037928) in view of Murphy (USPN 3819180).

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Regarding claims 2, 8, and 12, Fujimaru discloses a putter having a club head body having a toe region, a heel region, a sole, and a top surface opposite the sole, a hosel coupled to the top surface and configured to accept a shaft, wherein the club head body has a toe thickness defined by a distance between the top surface and the sole in the toe region and a heel thickness defined by a distance between the top surface and the sole in the heel region (See Figure 2). The toe thickness is greater than the heel thickness, as shown in Figure 2, and the heel region is weight-compensated to substantially balance with the toe region as shown in Figure 1 (See Entire Document). Fujimaru does not disclose the hosel being located at substantially the midpoint between the toe region and the heel region. Murphy discloses a putter having a hosel located at substantially the midpoint between the toe region and the heel region (See Figure 1 and Column 4, lines 42 through 52). One having ordinary skill in the art would have found it obvious to have the hosel located at the midpoint of the club head body, as taught by Murphy, to minimize the tendency to turn or twist during a stroke. It should be noted that applicant uses the term "hosel" to define any attachment means such as a bore (See Column 3, paragraph 0014 of applicant's specification). Figures 2, 3, 7 and 10 of Fujimaru clearly show the top surface opposite the sole parallel with a reference surface wherein the top surface is parallel with the reference surface.

Regarding claims 9 and 10, Applicant recites on page 4, paragraph 0018

"Top surface 130 may be of any suitable shape, width, and length. . . . The present invention, however, is not so limited, and contemplates any suitable club head shape."

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have a concave top surface.

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Applicant has not set forth that having a concave top surface provides any advantage, particular purpose, or solves a stated problem. One having ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally as well with the top surface of Fujimaru because it provides a means to which the hosel may be coupled to the club head body.

Regarding claim 11, though Fujimaru does not explicitly disclose the toe-up factor being 1.20 to 1.40, one having ordinary skill in the art would have recognized that Fujimaru inherently has a toe-up factor being that the drawings show the heel region being less than the toe region and that any factor may be multiplied to the thickness of the heel region such that the value equals that of the toe region. Furthermore, applicant does not disclose why the values of the toe-up factor are critical in order to attain the invention; therefore, one having ordinary skill would have found it obvious to have the toe-up factor of any value so long as the invention is attained (See *Gardner v. TEC Systems, Inc., et al.* 220 USPQ 777).

Regarding claim 13, Fujimaru discloses the heel region weight compensated such that the center of gravity of the club head' body lies in the heel region (See Entire Document). One having ordinary skill in the art would have drawn therefrom that the center of gravity may be at any location so long as the invention is attained and, therefore, would have concluded that the location of the center of gravity is obvious.

Regarding claim 14, in the broadest reasonable interpretation, Fujimaru discloses the final product in which the applicant claims. Therefore, it is submitted that the club head body as shown in figures 1 and 2, have a first toe cut-out (cut out extending from

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the top of the toe side to the recess bottom of the toe side) having a first depth and a heel cut out (concave groove near the hosel) having a second depth wherein the first depth is greater than the second depth.

Response to Arguments

Applicant's arguments filed 5/13/05 have been fully considered but they are not persuasive. Applicant agrees the following issue:

- a) Claims rejected under 112, first paragraph;
- b) claims rejected under 35 USC 102; and
- c) claims rejected under 35 USC 103..

With respect to the claims rejected under 112, first paragraph, applicant argues that the toe-up factor is enable by the specification. The rejection under 112, first paragraph has been removed; however, the examiner see the toe-up factor to only be an arbitrary factor made up by the applicant in which does not assert any novelty to the invention. Applicant notes that any suitable toe-up factor may be used based on any number of design factors. It appears that the applicant only concern is that the toe be thicker than the heel.

With respect the claims rejected under 35 USC 102, Applicant should look at Fujimaru more closely. Figures 2, 3, 7 and 10 clearly show the top surface opposite the sole parallel with a reference surface wherein the top surface is parallel with the reference surface.

With respect to the claims rejected under 35 USC 103, See the above.

For theses reasons, the above office action has been furnished.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAN

Alvin A. Hunter, Jr.



EUGENE KIM
PRIMARY EXAMINER